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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/508,793	05/03/2005	Akira Ohba	046124-5322	3905
55694 7590 01/19/2007 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209			EXAMINER HO, ALLEN C	
			ART UNIT	PAPER NUMBER
			2882	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/508,793

Applicant(s)

OHBA ET AL.

Examiner

Allen C. Ho

Art Unit

2882

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-6 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, another x-ray reflection means that reflects the x-ray emitted from the x-ray source in the direction of optical axis of the object lens claimed in claim 4 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4 recites "said another x-ray reflection means reflects the x-ray emitted from the x-ray source in the direction of optical axis of the objective lens thereby leading it to the sample". The specification does not describe an x-ray reflection means that reflects the x-rays emitted from the x-ray source (1) in the direction of optical axis of the objective lens thereby leading it to the sample.

4. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 4 recites "said another x-ray reflection means reflects the x-ray emitted from the x-ray source in the direction of optical axis of the objective lens thereby leading it to the sample". The x-ray reflection means (22) described by the specification does not reflect x-rays emitted from the x-ray source (1) in the direction of optical axis of the objective lens.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagai *et al.* (U. S. Patent No. 5,434,901) in view of Thieme *et al.* (U. S. Patent No. 5,222,113).

With regard to claims 1 and 3, Nagai *et al.* disclosed an x-ray image magnifying device comprising: an illumination optical system (81) for irradiating the x-rays emitted from an x-ray source to a sample; an objective lens (83) configured by a grazing incident mirror (a Wolter optical system) composed of a rotary hyperboloidal surface and a rotary ellipsoidal surface (column 9, line 58 - column 10, line 5) for magnifying and focusing the x-ray having penetrated through the sample onto a predetermined position (column 13, line 66 - column 14, line 2); and an x-ray image detecting means (85) for detecting the x-ray image focused by the objective lens.

However, Nagai *et al.* failed to disclose a focusing magnification adjusting means for adjusting the focusing magnification of the x-ray image by moving the x-ray image detecting means along the optical axis direction.

Thieme *et al.* disclosed a focusing magnification adjusting means (8) for adjusting the focusing magnification of the x-ray image by moving an x-ray image detecting means (6) along the optical axis direction (column 3, lines 57-60).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a focusing magnification adjusting means for adjusting the

focusing magnification of the x-ray image by moving at least one of the x-ray image detecting means, the sample, and the illumination optical system along the optical axis direction, since a person would be motivated to adjust the focus magnification to bring a feature in the sample into focus.

With regard to claim 2, Nagai *et al.* and Thieme *et al.* disclosed the x-ray image magnifying device according to claim 1, further comprising: a light irradiation means (Nagai *et al.* 31) for irradiating the sample with a visible light or an ultraviolet light; and a light detecting means (Nagai *et al.* 35) for detecting an image by a light which has penetrated through the sample had has been reflected by the objective lens.

With regard to claim 5, Nagai *et al.* and Thieme *et al.* disclosed the x-ray image magnifying device according to claim 1, wherein the x-ray image detecting means is moved so as to satisfy the following numerical express: $b=aM$ (this expression is automatically satisfied by a Wolter optic).

With regard to claim 6, Nagai *et al.* and Thieme *et al.* disclosed the x-ray image magnification device according to claim 1. However, Nagai *et al.* and Thieme *et al.* failed to disclose an illumination optical system adjusting means for optimizing the x-ray emitted from the x-ray source by moving the illumination optical system along the optical axis direction.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an illumination optical system adjusting means, since a person would be motivated to position the sample at the focal point of the illumination optical system.

Allowable Subject Matter

7. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 13 October 2006 with respect to the drawings have been fully considered and are persuasive. The objections of the drawings have been withdrawn.
9. Applicant's arguments filed 13 October 2006 with respect to the specification have been fully considered and are persuasive. The objections of the specification have been withdrawn.
10. Applicant's arguments filed 13 October 2006 with respect to claim 1 have been fully considered and are persuasive. The objection of claim 1 has been withdrawn.
11. Applicant's arguments filed 13 October 2006 with respect to claim 3 have been fully considered and are persuasive. The rejection of claim 3 under 35 U.S.C. 112, second paragraph, has been withdrawn.
12. Applicant's arguments filed 13 October 2006 have been fully considered but they are not persuasive.

With regard to the rejection of claim 1, the applicants argue that Thieme *et al.* taught away from adjusting magnification while employing a Wolter optical system. The examiner respectfully disagrees. The imaging error mentioned by Thieme *et al.* is directed to the imperfection in a Wolter optic, which is due to the so-called angle-tangent error (column 1, lines 12-24). This teaching in no way discourages the use of a focusing magnification adjusting

means. The applicants further argue that Thieme *et al.* disclosed a zone plate optical system, not a Wolter optical system. While this is true, nowhere in the rejection did the examiner suggest substituting a zone plate optical system for the Wolter optical system in the microscope disclosed by Nagai *et al.* Since the Wolter optical system is a focusing optical system like the zone plate optical system, it would be obvious to provide a focusing magnification adjusting means to adjust a distance between the Wolter optical system and the x-ray image detector to bring an image into focus.

Therefore, the rejection is being maintained.

Conclusion

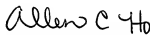
13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen C. Ho whose telephone number is (571) 272-2491. The examiner can normally be reached on Monday - Friday from 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward J. Glick can be reached on (571) 272-2490. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Allen C. Ho, Ph.D.
Primary Examiner
Art Unit 2882

08 January 2007